

IFW



Practitioner's Docket No.

1525B/116

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application
of _____

Inventor(s)

for _____

Title of invention

OR

In re application of: Shapiro et al.

Application No.: 10/786,355

Group No.: 2131

Filed: February 25, 2004

Examiner: Not Yet Assigned

For: System and Method for Providing Access to Verified Personal Background Data

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
WITHIN THREE MONTHS OF FILING OR
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. SECTION 1.97(b))

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

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Patents, P.O. Box 1450, Alexandria, VA 22313-1450

[] transmitted by facsimile to the Patent and Trademark
Office.

Date: December 29, 2004

Signature 

Jeffrey T. Klayman

(type or print name of person certifying)

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant: (1) within three months of the filing date of a national application; (2) within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or (3) before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

NOTE: The "filing date of a national application" under 37 C.F.R. section 1.97(b) has two possible meanings. Where the filing is a direct one to the United States Patent & Trademark office, the filing is defined in 37 C.F.R. section 1.53(b) as "the date on which: (1) A specification containing a description pursuant to section 1.71 and at least one claim pursuant to section 1.75; and (2) any drawing required by section 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by section 1.41." 37 C.F.R. section 1.97(b)(1). On the other hand, an international application that enters the national stage occurs when the applicant has filed the documents and fees required by 35 U.S.C. section 371(c) within the periods set forth in section 1.494 or section 1.495. 35 U.S.C. section 371(c) requires the filing of the following: (1) the basic national fee; (2) a copy of the international application, unless already sent by the International Bureau, and optionally an English translation if filed in another language; and, also optionally (3) amendments under PCT Article 19, with a translation into English if made in another language; (4) an oath or declaration; and (5) a translation into English of any annexes to the international preliminary examination report, if such annexes were made in another language. The optional items must be submitted later, with surcharges. 37 C.F.R. section 1.97(b)(2).

IDENTIFICATION OF TIME OF FILING THE ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

The information disclosure statement submitted herewith is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 C.F.R. section 1.97(b).

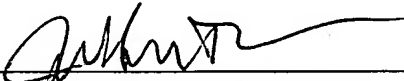
NOTE: "No certification or fee is due when the filing is made within the above time period. It is advisable to ensure that no Office action has been mailed if the disclosure statement is delayed until after three months from filing."

NOTE: "An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of a mailing if accompanied by a properly executed certificate of mailing under 37 C.F.R. 1.8, or Express Mail certificate under 37 C.F.R. 1.10. An office action is mailed on the date indicated in the Office action." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "The term 'national application' includes continuing applications (continuations, divisions, continuations-in-part) so three-months will be measured from the actual filing date of an application as opposed [sic] to the effective date of a continuing application." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 C.F.R. section 1.142) or just a requirement for additional fees to have a claim considered (37 C.F.R. section 1.16(d)). Thus, if an application was filed on Jan. 1 and the first Office action on the merits was not mailed until six months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

WARNING: "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. section 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63).



SIGNATURE OF PRACTITIONER

Reg. No. 39,250

Jeffrey T. Klayman

(type or print name of practitioner)

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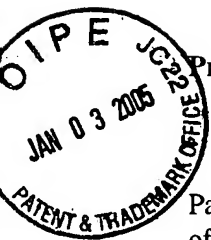
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1525B/00116 352512.1



Practitioner's Docket No.

1525B/116

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application
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Inventor(s)

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Title of invention

the specification of which is being transmitted herewith

OR

In re application of: Shapiro et al.

Application No.: 10/786,355

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Examiner: Not Yet Assigned

For: System and Method for Providing Access to Verified Personal Background Data

Mail Stop Amendment

Commissioner for Patents

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Alexandria, VA 22313-1450

(Information Disclosure Statement--page 1 of 9)

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10*

(When using *Express Mail*, the *Express Mail* label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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Date: December 29, 2004

Jeffrey T. Klayman

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***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).
"Since the filing of correspondence under section 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable C.F.R.e. requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

INFORMATION DISCLOSURE STATEMENT

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

NOTE: The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

WARNING: "No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).

List of Sections Forming Part of This Information Disclosure Statement

The following sections are being submitted for this Information Disclosure Statement:

(check sections forming a part of this statement: disC.F.R.d unused sections and number pages consecutively)

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☒ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☐ Concise Explanation of Non-English Language Listed Information Items
 - 7A. ☐ EPO Search Report
 - 7B. ☐ English Language Version of EPO Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

(complete the following, if appropriate)

Sections _____, respectively, have been continued on ADDED PAGE(S).

NOTE : "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

Section 1. Preliminary statements

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.



SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Shapiro et al. Attorney Docket: 1525B/116
 Serial No: 10/786,355 Art Group Unit: 2131
 Date Filed: February 25, 2004 Examiner Name: Not Yet Assigned
 Invention: System and Method for Providing Access to Verified Personal Background Data

**LIST OF PATENTS AND PUBLICATIONS FOR
 APPLICANT'S INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
	AA	US 5070452	Dec. 3, 1991	Doyle, Jr. et al.	364/401
	AB	US 5164897	Nov. 17, 1992	Clark et al.	364/401
	AC	US 5384703	Jan. 24, 1995	Withgott et al.	364/419
	AD	US 5416694	May 16, 1995	Parrish et al.	364/401
	AE	US 5418951	May 23, 1995	Damashek	395/600
	AF	US 5537586	July 16, 1996	Amram et al.	395/600
	AG	US 5649186	July 15, 1997	Ferguson	395/610
	AH	US 5706507	Jan. 6, 1998	Schloss	395/615
	AI	US 5758324	May 26, 1998	Hartman et al.	705/1
	AJ	US 5799304	Aug. 25, 1998	Miller	707/7
	AK	US 5832447	Nov. 3, 1998	Rieker et al.	705/2
	AL	US 5832497	Nov. 3, 1998	Taylor	707/104
	AM	US 5862223	Jan. 19, 1999	Walker et al.	380/25
	AN	US 5864871	Jan. 26, 1999	Kitain et al.	707/104
	AO	US 5884270	March 16, 1999	Walker et al.	705/1
	AP	US 5884272	March 16, 1999	Walker et al.	705/1
	AQ	US 5905862	May 18, 1999	Hoekstra	395/200
	AR	US 5956400	Sept. 21, 1999	Chaum et al.	380/4
	AS	US 5978768	Nov. 2, 1999	McGovern et al.	705/1
	AT	US 6061789	May 9, 2000	Hauser et al.	713/168
	AU	US 6115709	Sept. 5, 2000	Gilmour et al.	707/9
	AV	US 6205480	March 20, 2001	Broadhurst et al.	709/225
	AW	US 6370510	April 9, 2002	McGovern et al.	705/1
	AX	US 6381592	April 30, 2002	Reuning	707/3
	AY	US 6466914	Oct. 15, 2002	Mitsuoka et al.	705/9
	AZ	US 6658400	Dec. 2, 2003	Perell et al.	707/1

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
	BA	WO	WO 99/22330	May 6, 1999	Janice Johnson	GO6F 19/00, 17/60
	BB	WO	WO 99/41878	Aug. 19, 1999	AT&T Corp.	Ho4L 9/32, GO6F 12/14, 1/00

OTHER DOCUMENTS			
Examiner Initials	Reference Number	Author	Title of Article, Title of Journal, Volume Number, Page Numbers, Date
	BC	Credentials LLC	www.degreechk.com , "Degree Verification Services," 18 pages
	BD	Pre-Employment Screening	www.discreetdatasystems.com , "Pre-Employment Screening," 2 pages
	BE	People Finder Service	www.nationsearch2.com , 6 pages
	BF	P. Gralla	Gralla, P., How E-Mail Works, How the Internet Works, Ziff-Davis Press, pages 44-49, 1996.
	BG	America's Job Bank	www.americasjobbank.com , "America's Job Bank," 2 pages
	BH	Background Check International, LLC	www.bcint.com , "Background Check International, LLC," 1 page
	BI	Background Check Professionals	www.bcpro.net , "Background Check Professionals," 3 pages
	BJ	Brainbench – The Skills Authority	www.brainbench.com , "Brainbench – The Skills Authority," 3 pages
	BK	ChoicePoint Inc.	www.choicepointinc.com , "ChoicePoint Inc.," 7 pages
	BL	DBT Online, Inc.	www.dbtonline.com , "DBT Online, Inc.," 8 pages
	BM	Experian	www.experian.com , "Experian," 10 pages
	BN	My References.com	www.myreferences.com , "My References.com," 5 pages
	BO	Powerpay.com	www.powerpay.com , "Powerpay.com," 5 pages
	BP	TansUnion	www.transunion.com , "TransUnion," 3 pages
	BQ	Yahoo	www.yahoo.com/business-and-economy/business-to-business/investigative-services , 3 pages
	BR	Quixtar Investments, Inc.	www.quixtar.com , Copyright 1999, 2000, Date accessed 11/19/03

Examiner Signature: _____

Date Considered: _____

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

Section 4. Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted

NOTE: "A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120." 37 C.F.R. section 1.98(d).

WARNING: "This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty." Notice of April 20, 1992 (1138 O.G. 37-41, 38).

WARNING: "Information which is cited or submitted to the Office in the parent application of a file wrapper continuing application under 37 C.F.R. section 1.62 will be part of the file before the examiner and need not be resubmitted in the continuing application. Likewise, the examiner will consider information cited or submitted to the Office in a parent application when examining a continuing application and thus this information need not be resubmitted unless applicant desires the information to be printed on the patent." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

WARNING: While a copy of a non-English language item of information need not be submitted, if it was previously submitted to, or cited by, the Office in a prior application, provided it is properly identified in this statement and this application relies on that earlier filing date under 35 U.S.C. 120, nevertheless, the requirement in section 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application. The concise explanation must explain the relevance, as presently understood by the person designated in section 1.56(c) most knowledgeable about the content of the information. Notice of January 9, 1992, 1135 O.G. 13-25, at 20.

[x] This application relies, under 35 U.S.C. section 120, on the earlier filing date of prior application SN.: 09/472,080, filed on December 23, 1999.

The following references were submitted to, and/or cited by, the Office in the prior application(s) and, therefore, are not required to be provided in this application:

BA through BR.

Section 6. Copies of Listed Information Items Accompanying This Statement

NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (1) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."

NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

(complete the following, if applicable)

☒ Exception(s) to above:

U.S. patent citations are not included pursuant to 37 CFR 1.98 9(a)(2)(i) and 37 CFR 1.491(b), in which the USPTO waived the requirement for submitting a copy of each cited U.S. patent and each U.S. patent application publication for all U.S. national patent applications filed after June 30, 2003 and for all international applications that have entered the national stage under 35 USC § 371 after June 30, 2003.

☒ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

Section 10. Identification of Person(s) Making This Information Disclosure Statement

The person making this certification is

(check each applicable item)

- (a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

Reg. No.: 39,250

Tel. No.: (617) 443-9292

Customer No.: 002101

1525B/00116 348767.1



SIGNATURE OF PRACTITIONER

Jeffrey T. Klayman
(type or print name of practitioner)

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P.O. Address

Boston, MA 02110